

REMARKS

Applicants have carefully reviewed the Office Action dated June 13, 2005, and respectfully request reconsideration in view of the foregoing amendments and the following remarks.

Claim 1 has been amended, Claim 2 has been canceled and Claims 6-11 have been withdrawn from consideration. Claim 2 has been incorporated into Claim 1 and in addition components A3), A4) and A5) of original Claim 2 have been amended. Support for these amendments is found at pages 10-14 of the specification. Support for the amendment to step III of Claim 1 is found at page 14, lines 23-26.

In Applicants' previous response they argued that the restriction between Inventions I and II was not proper. In response the Examiner stated

Because the final product 2K coating composition is not merely a combination of the product from group I and a crosslinking agent, the relationship does not qualify as a combination/subcombination. There is additional structure in the fact that the components of the 2K coating composition must be present in separate containers, as opposed to a composition where they are simply combined.

Applicants do not understand this argument. A "two-component" coating composition is a term of art. It means that the components must be separate. There is no reason for Applicants to state that the components are in separate containers, because the term "two-component" is understood to mean that the components are separately stored. If they are admixed, then the components will react resulting in a cured composition. In this altered form, they are not present as a combination-subcombination. It is only when the components are separate, that they are present as a combination-subcombination.

Subheading of II of MPEP § 806.05(c) states that when the subcombination is essential to the combination for patentability, then the requirement for restriction cannot be made. MPEP § 806.05(c) also states that

In applications claiming plural inventions capable of being viewed as related in two ways, for example, as both combination-subcombination and also as different statutory categories, both applicable criteria for distinctness must be demonstrated to support a restriction requirement. See also MPEP § 806.04(b).

This means that whether or not the Examiner can satisfy MPEP § 806.04(b) is irrelevant unless the Examiner can also satisfy MPEP § 806.05(c).

In view of the preceding remarks Applicants again submit that the Examiner has failed to satisfy the requirements necessary to restrict between Inventions I and II. Accordingly, it is requested that the restriction requirement be withdrawn and Claims 6-8 be examined with Invention I.

Claims 1-5 and 12 have been rejected under 35 USC 112, second paragraph, as being indefinite for the following reasons.

A. The phrase "in the presence where appropriate of vinylically unsaturated monomers" renders the claim indefinite because it is unclear whether or not and to what extent the limitation(s) corresponding to "where appropriate" is actually a required part of the claimed invention.

Applicants traverse this rejection in view of the amendment to Claim 1 to indicate that the preparation of polyurethane (A) is optionally carried out in the presence of vinyl monomers (B).

B. There is no antecedent basis for the limitation "at least some of the neutralizable groups" since no neutralizable groups are previously identified or defined.

Applicants traverse this rejection in view of the amendment to step III of Claim 1 to require the optional neutralization of any potential ionic groups introduced via component (A3) as disclosed at page 14, lines 23-26. Potential ionic groups are either acid groups or tertiary amine groups that must be neutralized before they provide hydrophilicity to the polyurethane.

In view of the preceding amendment and remarks, Applicants submit that the claims are in full compliance with 35 USC 112, second paragraph. Accordingly, withdrawal of this rejection is requested.

Claims 1-5 and 12 have been rejected under 35 USC 102(b) as being anticipated by WO 2001/77200 to Kagerer et al, which is believed to correspond to U.S. Patent Application 2003/0124357.

Applicants traverse this rejection in view of the amendments to Claim 1, which require the isocyanate-reactive compounds used to prepare polyurethane (A) to consist of isocyanate-reactive components (A2), (A3), (A4) and (A5). Each of these components has been amended to limit the isocyanate-reactive groups to hydroxyl and/or amino groups and in the case of component (A3) to acid groups, even though these groups generally do not react with isocyanate groups. The thiol groups required by Kagerer et al are excluded by the subject claims.

Kagerer et al is directed to a graft copolymer prepared by graft polymerizing at least one hydrophobic or hydrophilic polyurethane containing on average at least one thiol group with at least one olefinically unsaturated monomer in solution or in a aqueous dispersion (paragraph 0031). Because the claimed polyurethanes exclude the presence of thiol groups, the subject claims are not anticipated by Kagerer et al. Accordingly, withdrawal of this rejection is requested.

The foregoing is believed to be a complete response to the Office Action dated June 13, 2005, and in view of the preceding amendments and remarks, a Notice of Allowance is respectfully requested.

Respectfully submitted,

By Thomas W. Roy
Thomas W. Roy
Agent for Applicants
Reg. No. 29,582

Bayer MaterialScience LLC
100 Bayer Road
Pittsburgh, Pennsylvania 15205-9741
(412) 777-3820
FACSIMILE PHONE NUMBER:
(412) 777-3902
s:\shared\kgb\twr049am